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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,381	10/16/2003	Thierry Fleurence	1948-4821	2245
27123	7590	11/12/2009		
MORGAN & FINNEGAN Transition Team C/O Locke Lord Bissell & Liddell 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER PICKARD, ALISON K	
			ART UNIT 3676	PAPER NUMBER
			NOTIFICATION DATE 11/12/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/688,381

**Applicant(s)**

FLEURENCE, THIERRY

**Examiner**

Alison K. Pickard

**Art Unit**

3676

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 10, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 7, 10, 11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Note: it is unclear if Applicant is now claiming the combination of the seal and optical unit due to some of the wording in the new limitations (e.g. section about compressive force, etc added to end of the claims). For purposes of examination, the claims are still being interpreted as subcombination claims wherein only the seal is being positively claimed and is capable of functioning in the intended environment.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 6, 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellw.

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Sellw teaches a seal having flexible sheet and an orifice. Sellw teaches using a lip(s) to improve sealing particularly where there are imperfections in the mating surface (see col. 2, lines 28-39). Thus, Sellw provides a teaching of a lip at any location where improved sealing is necessary. Providing the lip(s) only at the first surface of the first side (i.e. no lip at the second surface) is considered obvious in a situation where that is the only location there may be imperfections. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use a lip on the first surface as taught by Sellew to improve sealing.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

Regarding claims 6 and 7, the claim language is broad enough that the portions of Sylvester can be divided to achieve the hardness/flexible limitations require by these claims. For example, if the ring in figure 2 is divided in thirds, two of those sections have "portions" which could just comprise layer 32. The remaining section (i.e. the center portion), could comprise a "portion" defined by all layers shown in Figure 3. Thus, the first and second portions would be more flexible than the central portion material. And, regarding claim 7, the first and second portions could be defined to include at least two of the layer so that the lip, which would be formed of only material 32, would be more flexible and different than all portions. OR, if considered a different way, even if each portion were to be defined to include all layers shown in Figure 3, the limitation is still met. Each portion would be comprised of several layers of material. Thus, the first and second portion would comprise layer 32, which is a material that is more flexible than layer 34 for example. And, the central portion would comprise the material 34. Thus, the requirement is met.

3. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellew as applied to claims 10 and 13 above, and further in view of Johnson.

Sellw does not appear to disclose the lips (Fig. 6) are different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lips different height to ensure a seal under all clamping forces.

4. Claims 1, 3, 6, 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Green (3,653,673).

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Green teaches a gasket with sealing lips (e.g. 12 and 13) used to improve the seal between bolt holes (which Sylvester can have). The lip is only provided on sides of the gasket (e.g. see fig. 2). Therefore, there would be portions of a gasket that would not have a lip as required. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of Sylvester with a lip only on a side as taught by Green since the use of a known method to improve a similar device yields expected results.

Regarding claims 6 and 7, the claim language is broad enough that the portions of Sylvester can be divided to achieve the hardness/flexible limitations require by these claims. For example, if the ring in figure 2 is divided in thirds, two of those sections have "portions" which could just comprise layer 32. The remaining section (i.e. the center portion), could comprise a "portion" defined by all layers shown in Figure 3. Thus, the first and second portions would be more flexible than the central portion material. And, regarding claim 7, the first and second

portions could be defined to include at least two of the layer so that the lip, which would be formed of only material 32, would be more flexible and different than all portions. OR, if considered a different way, even if each portion were to be defined to include all layers shown in Figure 3, the limitation is still met. Each portion would be comprised of several layers of material. Thus, the first and second portion would comprise layer 32, which is a material that is more flexible than layer 34 for example. And, the central portion would comprise the material 34. Thus, the requirement is met.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

5. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Green as applied to claims 10 and 13 above, and further in view of Johnson.

Green does not appear to disclose plural lips with different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use plural lips with different height to ensure a seal under all clamping forces.

#### ***Response to Arguments***

6. The examiner has considered the arguments of 10-27-09 and withdrawn the use of Hance in light of these arguments. It appears the examiner misinterpreted what was being shown in Figure 1. However, as set forth above, Sylvester still meets the flexibility limitations require in

claims 6 and 7. Because the claims are considered “open” claims (due to use of “comprise”) and written broadly with terms such as “portion,” the reference is subject to a broad interpretation. The examiner has presented at least two examples of how the reference could be interpreted to meet the limitations. Other art has also been cited, such as Lonne '939 or Belter, which teach varying the density/flexibility of a gasket in different sections. Either of these could be used to modify Sylvester, however such a combination is not considered necessary at this time.

Applicant has again argued the teaching of Sellaw. The examiner still disagrees and considers Sellaw to teach the use of a bead where ever it is need. As noted before, Sellaw is not limited to the Figures. Green has also been applied as it also teaches the use of a bead only in certain sections of a gasket, such as between bolt holes. Also note Udagawa '614.

Applicant also argues that neither combination produces a lip providing a point of compression against the optical unit. First, Applicant should note the first paragraph at the top of the action. If the argument is that there is no optical unit disclosed, this argument is unpersuasive. As stated, the claims are interpreted as only the subcombination of just the seal that is capable of being used with an optical unit. (If Applicant intends to claim the combination of the seal and the unit, all claims will be withdrawn due to election by original presentation.) If the argument is that the bead does not provide a point of compression, the examiner disagrees. The seal, and thus the bead, are compressed between mating members. The top of the lip/bead will therefore provide a compressive force (considered inherent).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/  
Primary Examiner, Art Unit 3676

AP